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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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08/976,820 11/25/97 LEIBER

J BEIERSDORF-4

IM22/1129  
SPRUNG KRAMER SCHAEFER AND BRISCOE  
660 WHITE PLAINS ROAD  
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EXAMINER

GUARRIELLO, J

ART UNIT

PAPER NUMBER

1771

DATE MAILED:

11/29/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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## Office Action Summary

|                                     |                                      |
|-------------------------------------|--------------------------------------|
| Application No.<br><b>68/976820</b> | Applicant(s)<br><b>LEIBER et al.</b> |
| Examiner<br><b>John Giamello</b>    | Group Art Unit<br><b>1771</b>        |

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

### Status

- ☐ Responsive to communication(s) filed on 11/24/97, 9/2/98, 3/3/99, 5/13/99
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- ☒ Claim(s) 1-9, 11-13 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-9, 11-13 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

### Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). #7
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

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### DETAILED ACTION

15. Examiner acknowledges preliminary amendments of 11/24/1997 paper # 5 and preliminary amendment of 5/13/1999, paper # 9 and other documents of 9/2/98 with status letter of 3/3/1999.
16. Examiner notes for the record that the German Search Report lists DE 44 228 49 C1 which is incorrect, it should be DE 42 228 49 of 6/17/1993. This was confirmed in conversation with Mr. Steve Ryan on 9/14/1999 about 5:30 pm EST, (see 5,626,932, column 1, lines 61-62).
17. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

18. Applicant is reminded of the proper language and format for an abstract of the disclosure.

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The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 250 words. It is important that the abstract not exceed 250 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

19. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

20. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 2, line 2, it is not clear what the structure encompasses, it appears that "both sides" could mean both faces of the tapes or it could be the two sides of the adhesive regions, clarify.

In claim 3, it is not clear what encompasses the ranges stated because there is a statement of a broad range and then a more narrow range identified by "particular"; it appears that the claim is in the form of an Improper Markush group, clarify.

In claim 12, it is not clear what the structure encompasses, see reasons in cite for claim 2.

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21. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Luhmann et al. 5,491,012.

Luhmann teaches the use of an adhesive film for a re-releaseable adhesive-bond with a tab for pulling, (see abstract; column 2, lines 4-30). It is the examiner's position that the claimed invention is a twosided adhesive film with tabs which film can be attached and reattached to a substrate by means of pulling on the tabs. Claims lack novelty. See column 6, lines 6-23).

22. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-3, 11-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Luhmann et al. 5,626,932.

Luhmann teaches the use of an adhesive film which can re-detached without residue, (see abstract). Luhmann teaches grip tabs for pulling, (column 2, lines 36-65). It is the examiner's

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position that the claimed invention is a two sided adhesive film with tabs which film can be attached and reattached to a substrate by means of pulling on the tabs. Claims lack novelty.

23. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-3, 11-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Luhmann et al. 5,725,923.

Luhmann teaches double sided adhesive film with tabs, (see abstract). Luhmann teaches that these films are removeable adhesive films and tabs can be incorporated on the films, (column 2, lines 6-67; column 3, lines 15-60). Claims lack novelty.

24. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

25. Claims 1-9, 11-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luhmann et al. 5725,923.

Luhmann teaches double sided adhesive film with tabs, (see abstract). Luhmann teaches that these films are removable adhesive films and tabs can be incorporated on the films, (column

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2, lines 6-67; column 3, lines 15-60). Luhmann differs from the claimed invention with regard to the shape of regions of the adhesive tape and the placement of the tabs.

It would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the teachings of Lumnann to modify the shape of the regions and placing of the appropriate tabs motivated with the expectation that the rearranging the parts of an invention involves only routine skill in the art, In re Japikse, 86 USPQ 70.

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Guarriello whose telephone number is (703) 308-3209. The examiner can normally be reached on Monday to Friday from 8 am to 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-5408.

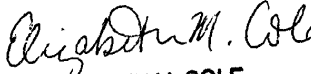
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

  
John J. Guarriello:vr:gj

Patent Examiner

October 20, 1999

November 19, 1999

  
ELIZABETH M COLE  
PRIMARY EXAMINER